

Appl. No. 09/773,241
Atty. Docket No. 8409
Amdt. dated January 5, 2005
Reply to Office Action of August 23, 2004
Customer No. 27752

REMARKS

Claim Status

Claims 1 - 19 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to more specifically characterize the claimed invention. Support for the amendment can be found in the specification as exemplified by Figures 1-9.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 102 Over Aledo et al.

The Office Action has rejected claims 1-3, 5-10, 14, and 16-17 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,850,988 issued to Aledo et al., hereafter "Aledo". However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully traverses the rejection by the Office Action because the cited reference fails to teach every element of amended claim 1.

First, the discontinuity of Aledo is not limited to an inner region as defined in the claimed invention. Caselaw provides that "[i]n the absence of an express intent to impart a novel meaning to the claim terms, the words take on the full breadth of the ordinary and customary meanings attributed to them by those of ordinary skill in the art." *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ 1001, 1009 (Fed. Cir. 2003). A claim term's ordinary and customary meaning may be determined by reviewing "the written description, the drawings, and the prosecution history." *Id.* (citing *DeMarini Sports, Inc. v. Worth, Inc.* 239 F.3d 1314 (Fed. Cir. 2001)). "It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the ordinary and customary meaning of the terms in the claims of a patent." *Ferguson* 350 F.3d at 1338.

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Amended claim 1 recites, *inter alia*, that the at least one side panel includes “an outer periphery and an inner region having at least one discontinuity limited to the inner region... wherein the at least one discontinuity is neither directly or indirectly connected to the outer periphery.” The term “inner region” is defined in the specification as shown in Figures 1-9. The inner region is shown to be an area of the side panel bounded by an outer periphery. In addition, whether a single discontinuity or a plurality of discontinuities, e.g. 260, 254, 256, 264, 266, 268, and 270, are shown, none of the discontinuities in any of the embodiments are directly or indirectly connected to the outer periphery.

In contrast, Aledo teaches a slit 17 and a slit 19 each of which extend from their side edges or side margins, respectively, inward and terminate at a circular cutout 18. (col. 3, lines 48-51; col. 4, lines 26-32). Aledo teaches that the circular cutout 18 is connected to the slits 17 and 19. (See Figures 1-3). Because the slits 17 and 19 touch and extend from their side edges or side margins, the circular cutout 18 is indirectly connected to the outer periphery of the side panel. Therefore, Aledo does not teach a “side panel... having at least one discontinuity limited to the inner region” of the side panel as is recited, *inter alia*, in amended claim 1.

Second, the Office Action states that the discontinuity (referring to Figure 3, item 18) is used “for dividing a tensile force applied to the at least one side panel into a waist-directing force and a leg-directing force as set forth in col. 3 lines 44-54 and col. 4 lines 10-17.” Aledo does not teach that the circular cutout 18 is used for dividing a tensile force. Instead, Aledo teaches that a force transmission can be interrupted by forming two separate adhesive regions from an adhesive region system by providing a cut “which allows the resulting two adhesive regions to work independently from” one another. (col. 1, lines 35-40)(emphasis added). The slits 17 and 19 are representative of the cut referenced above. (See Figures 1-3).

Aledo teaches that circular cutout 18 distributes forces applied thereto along its circular surface. (col. 3, lines 52-54). However, Aledo teaches that in doing so, the circular cutout 18 “helps prevent undesirable tearing of the diaper.” (col. 3, lines 51-53). Aledo further teaches that the circular cutout 18 prevents tearing “when stresses are applied in the regions surrounding the slit.” (col. 4, lines 31-33). However, Aledo does

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not teach or suggest that the circular cutout 18 is used to divide a tensile force into a waist-directing force and a leg-directing force as asserted by the Office Action.

Third, in support of its rejection, the Office Action states that the discontinuity of Aledo is limited to an inner region and asserts that "the entire portion shown by Aledo may be considered an inner region." (Office Action page 7). Applicant is unsure of what the term "entire portion" refers to. However, because the Office Action asserts that the discontinuity of Aledo is limited to an inner region and because the slits 17 and 19 touch or extend from their side edges, the "entire portion" or inner region of Aledo is clearly different from the inner region of the claimed invention.

For the foregoing reasons, Aledo does not teach or suggest a "side panel including an outer periphery and an inner region having at least one discontinuity limited to the inner region... wherein the at least one discontinuity is neither directly or indirectly connected to the outer periphery" as recited, *inter alia*, in amended claim 1. Therefore, Applicant asserts that claim 1 is not anticipated by Aledo and is in condition for allowance because Aledo fails to teach every element of amended claim 1. Furthermore, because claims 2-3, 5-10, 14, and 16-17 depend from claim 1, they too are not anticipated by Aledo and therefore, are in condition for allowance.

Rejection Under 35 USC § 103(a) Over Aledo et al.

The Office Action has rejected claims 4, 18, and 19, under 35 U.S.C. § 103(a) as being obvious in view of Aledo. However, in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicant respectfully traverses the rejection of the Office Action because the Office Action fails to establish a *prima facie* case of obviousness.

First, the Office Action supports its rejection by stating that:

Aledo discloses a disposable article with elastic extensibility in the waist and leg areas (Figure 1 members 13 and 14), but fails to disclose specifically wherein the

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waist region has an extensibility varying from about 5g/mm to about 50 g/mm and the leg region has an extensibility ranging from about 1 g/mm to about 50 g/mm; wherein the side panel is elastic and has an elasticity of at least about 5%. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the waist and leg elasticity with specific parameters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

(Office Action pages 5-6).

However, *In re Aller*, pertains to an optimized process for producing phenol. In this case, the court noted that the appellant's process was identical to that disclosed in the prior art with the exception of lower temperature ranges and higher sulphuric acid concentrations than those shown in the prior art reference. *Id.* Unlike the prior art reference in *In re Aller*, Aledo, does not teach any preexisting ranges for extensibility or elasticity. In addition, the Office Action cites waist and leg areas 13 and 14 of Aledo for support of its assertion. However, elements 13 and 14 of Aledo are not shown to be a part of the alleged side panel. (See Figures 1-3). Therefore, even if Aledo did teach ranges of extensibility and elasticity, they would be in regard to the waist area and leg area which are not a part of the alleged side panel of Aledo. Consequently, Aledo does not disclose the "general conditions" of claims 4, 18, and 19. Therefore, Applicant is not merely discovering the optimum or workable ranges when Aledo does not teach or suggest the "general conditions" of the claims nor the claimed ranges therein.

Second, assuming *arguendo* that Aledo did teach the claimed ranges, the Office Action still does not establish a *prima facie* case of obviousness because the cited reference does not teach all of the claim limitations of the claimed invention. As described above with regard to the anticipation rejection, Aledo does not teach all of the claim limitations of amended claim 1. Specifically, Aledo does not teach or suggest a "side panel including an outer periphery and an inner region having at least one discontinuity limited to the inner region... wherein the at least one discontinuity is neither directly or indirectly connected to the outer periphery." Because claims 4, 18, and 19 depend from claim 1, Aledo similarly fails to teach or suggest all of their claim limitations.

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For the foregoing reasons, claims 4, 18, and 19 are nonobvious over Aledo. Therefore, Applicant asserts that claims 4, 18, and 19 are in condition for allowance.

Rejection Under 35 USC 103(a) Over Aledo et al. in view of Zelazoski et al.

Claims 11-13 and 15 have been rejected under 35 USC 103(a) as being unpatentable over Aledo in view of U.S. Pat. No. 5,536,555 issued to Zelazoski et al., hereafter "Zelazoski". Applicant respectfully traverses the rejection by the Office Action because the Office Action has failed to establish a *prima facie* case of obviousness against claims 11-13 and 15.

First, there is no motivation to make the suggested combination of references because Aledo teaches away from a combination with Zelazoski. Caselaw provides that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See *United States v. Adams*, 383 U.S. 39, 52 148 USPQ 479, 484 (1966).

Zelazoski teaches a quilted film laminate having a plurality of slits through a film layer 12. (col. 4, lines 53-55). The film layer 12 is bonded to a substrate layer 14 which provides strength and caliper to the composite. (col. 5, lines 52-57). As discussed previously, Aledo teaches an adhesive region system which comprises two adhesive regions created by a cut which extends from an interior area of an alleged side panel and transcends the outer edge of the alleged side panel. (See Abstract). However, Aledo utilizes a single slit to accomplish the "two distinctive adhesive regions 15 and 16." (col. 3, lines 3-5). Because the slit taught by Aledo, i.e. 17 and 19, would be sufficient to create the "two distinctive adhesive regions 15 and 16," one skilled in the art would be discouraged from incorporating the teachings of Zelazoski into Aledo. Specifically, one skilled in the art would not use a plurality of cut lines to accomplish the two separate adhesive regions taught by Aledo. Because one skilled in the art would not make the suggested combination of references, there is no motivation to combine the cited references.

Second, in further support of its rejection, the Office Action states that "it would have been obvious to one of ordinary skill in the art to modify Aledo by providing the

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laminate of Zelazoski because the quilted film laminate provides good intake of liquids and resistance to rewet as taught by Zelazoski in col. 2, lines 35-48." (Office Action page 7). However, while Zelazoski may teach a laminate which provides a good intake of liquids and resistance to rewet, the Office Action's proposed use of the invention of Zelazoski is in the side panel of Aledo. The side panels of the absorbent article are not readily susceptible to liquid incidents. Consequently, one skilled in the art would not consider the ability of the side panel to intake liquids or similarly the side panel's resistance to rewet when considering material for the construction of a side panel. Therefore, one skilled in the art, after reading Zelazoski, would not be motivated to use the invention of Zelazoski in a side panel.

Third, there is no motivation to combine the suggested references because the addition of Zelazoski to Aledo would change the principle operation of Aledo. Caselaw provides that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.02 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

As discussed previously, Aledo teaches a creation of "two distinctive adhesive regions 15 and 16" via slits 17 or 19. The incorporation of a plurality of slits, as taught by Zelazoski, would provide the article of Aledo with more than two distinctive adhesive regions. Thus, there is no motivation to combine Aledo with Zelazoski and the suggested Aledo / Zelazoski combination is not sufficient to render claims 11-13 and 15 *prima facie* obvious.

For the foregoing reasons, claims 11-13 and 15 are nonobvious over Aledo in view of Zelazoski. Therefore, Applicant asserts that claims 11-13 and 15 are in condition for allowance.

Conclusion

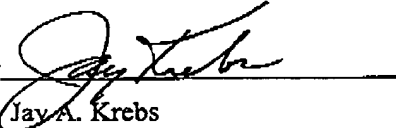
In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) and § 103(a). Early and favorable action in the case is respectfully requested.

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This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-19 is respectfully requested.

Respectfully submitted,
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